

**Re.** : Response to Office Action mailed August 23, 2004  
**Appl. No.** : 10/727,065  
**Filed** : December 3, 2003

## **II. REMARKS**

Claims 1-13 are currently pending in the application and the Office Action rejected Claims 1-13. By the foregoing amendments, Applicants amended Claims 1, 2 and 6-11; cancelled Claim 4 without prejudice; and added new Claims 14-27 to clarify, more clearly define and/or broaden the claimed invention, and expedite receiving a notice of allowance. Pursuant to 37 C.F.R. § 1.121(f), no new matter is introduced by these amendments. Applicants believe that Claims 1-3 and 5-27 are now in condition for allowance.

Please note that Applicants' remarks are presented in the order in which the issues were raised in the Office Action for the convenience and reference of the Examiner. In addition, Applicants request that the Examiner carefully review any references discussed below to ensure that Applicants' understanding and discussion of the references, if any, is consistent with the Examiner's. Further, the following remarks are not intended to be an exhaustive enumeration of the distinctions between any particular reference and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and that reference.

### **A. Response to the Section 102(b) Rejection**

The Office Action rejected Claims 1-5, 7, 8, and 11-13 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,347,831 by Nye et al. The Office Action asserts that Figures 1-7 of the Nye '831 patent shows claimed structure, including a blow-molded table top, seat members supported by pivotally mounted legs (39,76), and a C-shaped foot member (26) slidably and adjustably couplable to the legs. The Office Action further asserts that, in the

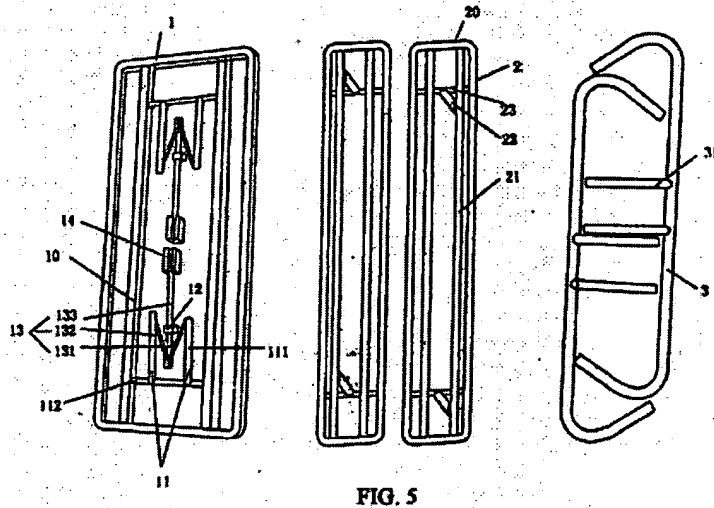
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Nye '831 patent, the undersides of the table and seat members form rails (figs. 9,10) for pivotally securing the legs thereto, and include storage areas for the legs when folded.

Applicants respectfully traverse this rejection. However, in order to further clarify, define and/or broaden the claimed invention, and expedite receiving a notice of allowance, Applicants amended Claim 1. For example, Applicants amended Claim 1 to provide "a first side rail connected to the first seat member," "a second side rail connected to the first seat member," and a first seat leg "movable between a collapsed position and an extended position, the collapsed position including the second end of the first seat leg being disposed proximate the bottom surface of the first seat member, proximate the first side rail and spaced away from the second side rail, the extended position including the second end of the first seat leg spaced apart from the bottom surface of the first seat member." Applicants also amended Claim 1 to provide that "the first bent end of the first foot member is slidably and detachably couplable to the first seat leg, and the second bent end of the first foot member is slidably and detachably couplable to the second seat leg." Thus, Claim 1 now recites, among other limitations, that **a first side rail, a second side rail, and a first seat leg movable between a collapsed position and an extended position, the collapsed position including the second end of the first seat leg being disposed proximate the bottom surface of the first seat member, proximate the first side rail and spaced away from the second side rail**. Further, Claim 1 now recites, among other limitations, **the first bent end of the foot member is slidably and detachably couplable to the first seat leg, and the second bent end of the foot member is slidably and detachably couplable to the second seat leg**.

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As best seen in Figure 5 of the present application, the seat legs 22 may be detached from the foot members 3. When detached, the seat legs 22 may be compactly disposed proximate the bottom surface of the seat members 2 to allow for smaller shipping packaging and thus help reduce shipping costs.



In contrast to this detachable configuration, the Nye '831 patent teaches against using detachable components and **even expressly states that it discloses a picnic table without any detachable parts**:

From the foregoing, it will be appreciated that **it would be an advancement in the art to provide a foldable picnic table that is fully self contained and does not have detachable parts**. It would be another advancement in the art to provide a foldable picnic table that can be folded, one side at a time, thereby reducing the complexity of operation, while providing a single, flat configuration, comprising both the table top and support benches positioned in a coplanar relationship for storage. It would also be an advancement in the art to provide a foldable picnic table that maximizes the amount of leg room for a person sitting anywhere at the table. It would further be an advancement in the art to provide a foldable picnic table having telescoping pedestals and bench supports that provide means for adjusting the table between a stage or platform position selectively at varying heights or a table top with support benches. Finally, it would be an advancement in the art to provide a comfortable foldable picnic table at which to sit.

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U.S. Patent No. 6,347,831, col. 1, line 61 to col. 2, line 11 (emphasis added). Accordingly, the Nye '831 patent discloses a less compact configuration, which would increase packaging costs and shipping costs.

Also, as shown in the present application, the ends of seat legs may be disposed at angle. For example, as shown in Figure 5, when in a collapsed position, the end portions of the seat legs 22 are positioned proximate one side rail and spaced apart from the other side rail; and when in an extended position, the seat legs 22 may facilitate a wider base.

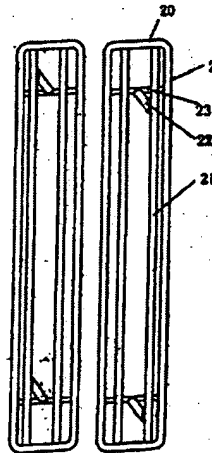


FIG. 5

In contrast, the Nye '831 patent discloses outer members (39) that are perpendicularly connected to mounting surfaces (62), which provides a narrower base.

Because the Nye '831 patent does not disclose each and every element of Claim 1, Applicants respectfully request that this Section 102(b) rejection be withdrawn. Applicants also request that this rejection of dependent Claims 2-3, 5, 7, 8 and 11-13 be withdrawn at least because these claims are dependent upon amended independent Claim 1.

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**B. Response to the First Section 103(a) Rejection**

The Office Action rejected Claim 6 under 35 U.S.C. § 103(a) as being obvious over the Nye '831 patent in view of United States Patent No. 2,939,516 by Drew. The Office Action asserts that, while the Nye '831 patent does not disclose a connecting block for securing the support braces thereto, such a block structure is conventional and well known in the art as shown by the Drew patent in Figures 2, 3, and 5. The Office Action further states that to have utilized such a block in place of the shaft structure of the Nye '831 patent would have been an obvious modification to one with ordinary skill in the art, as both provide a similar function.

Applicants respectfully traverse this rejection. However, as described above, Applicants have amended Claim 1. Applicants request that this rejection of Claim 6 be withdrawn at least because this claim is dependent upon amended independent Claim 1.

**C Response to the Second Section 103(a) Rejection**

The Office Action rejected Claims 9 and 10 under 35 U.S.C. § 103(a) as being obvious over the Nye '831 patent in view of United States Patent No. 5,921,623 by Nye, et al. The Office Action asserts that the use of angled leg members to support the seat of a picnic table is old in the art as shown by the Nye '623 patent. The Office Action further states that to have applied such angled legs to the seat supports of the Nye '831 patent, by forming the telescoping seat legs and corresponding bent ends of the foot member at an oblique angle, would have been well within the level of skill in the art, thereby providing a more aesthetically pleasing support structure.

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Assuming for the sake of argument that the Office Action correctly asserts that its proposed modification of the Nye '831 patent was "well within the level of skill in the art," Applicants nevertheless respectfully traverse this rejection because **there is no suggestion or motivation to make that modification**. The MPEP states that a combination or modification is not proper without a suggestion or motivation "to modify the reference or combine reference teachings." See MPEP § 2143 at 2100-129 (8th ed. rev. 2 2004). The MPEP adds: "The mere fact that references can be combined or modified does not render the resultant combination obviousness unless the prior art also suggests the desirability of the combination." See *id.* § 2143.01 at 2100-131 (emphasis added). Indeed, "[a]lthough a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.'" See *id.* § 2143.01 at 2100-131 (emphasis added). Thus, notwithstanding the ability of one skilled in the art to make a modification, the prior art must provide a suggestion to make that modification.

Here, neither reference would suggest the claimed combination of Claims 9 or 10. The Nye '623 patent discloses angled, one-piece end portions 30, but does not disclose the telescoping construction of the Nye '831 patent. Months after filing the application for the Nye '623, the same three inventors filed the application for the Nye '831 patent to disclose their telescoping construction. But this telescoping construction merely includes inner members 37 coupled to outer members 39 perpendicularly (rather than obliquely) connected to mounting surfaces 62. Notwithstanding their intimate knowledge of the Nye '623 patent, none of three the inventors provided any teaching or suggestion in the Nye '831 patent that their

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**telescoping construction could use oblique angles. If it wasn't obvious to the inventors of both the '623 and '831 patents, it surely wouldn't be obvious to one of ordinary skill.**

Because there is no suggestion or motivation to modify the Nye '831 patent as proposed by the Office Action, Applicants respectfully submit that Claims 9 and 10 are allowable. Nevertheless, as mentioned above, Applicants amended Claim 1 in order to further clarify, define and/or broaden the claimed invention, and expedite receiving a notice of allowance. In view of the foregoing, Applicants request that the rejection of Claims 9 and 10 be withdrawn at least because these claims are dependent upon amended independent Claim 1.

#### **CONCLUSION**

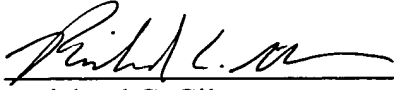
Applicant submits that Claims 1-3 and 5-27 are allowable over the cited references and are in condition for allowance. Accordingly, Applicant requests that a Notice of Allowance be promptly issued.

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If any further impediments to allowance of this application remain, the Examiner is cordially invited to contact the undersigned by telephone so that these remaining issues may be promptly resolved.

Respectfully submitted,

Dated: February 22, 2005

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